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[REDACTED] EXAMINER

LUGO, CARLOS

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3677

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Please find below and/or attached an Office communication concerning this application or proceeding.

8

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/753,093	LEI, JONATHAN L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Carlos Lugo	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_\_.

2a) This action is **FINAL**.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) 13-70 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 02 January 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, drawn to a self-contained business transaction capsule, classified in class 705, subclass 27.
  - II. Claims 13-31, drawn to a mobile commerce system, classified in class 705, subclass 27.
  - III. Claims 32-44, drawn to a portable electronic device, classified in class 455, subclass 3.01.
  - IV. Claims 45-58, drawn to a method of providing a self-contained business transaction capsule, classified in class 705, subclass 27.
  - V. Claims 59-70, drawn to a self-contained business transaction capsule in a mobile commerce system, classified in class 705, subclass 27.
2. The inventions are distinct, each from the other because of the following reasons:
  - Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the self-contained business transaction capsule does not require an output transformer, it can be previously recorded or placed in the portable electronic device.

- Inventions Group I and Group III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the self-contained capsule does not require a data storage medium.
- Inventions Group I and Group IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the capsule can be originally recorded or placed when the portable electronic device was assembled instead of broadcasted to the portable electronic device.
- Inventions Group I and Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the self-contained business transaction capsule can be previously recorded in the portable electronic device.

- Inventions Group II and Group III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the portable electronic device can use a different system to obtain the capsule (by previously recorded in the portable electronic device).
- Inventions Group II and Group IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the capsule can be originally recorded or placed when the portable electronic device was assembled instead of broadcasted to the portable electronic device.
- Inventions Group II and Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the capsule can be originally recorded or placed when the portable electronic device was assembled instead of broadcasted to the portable electronic device.

- Inventions Group III and Group IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the capsule can be originally recorded or placed when the portable electronic device was assembled instead of broadcasted to the portable electronic device.
- Inventions Group III and Group V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the capsule can be originally recorded or placed when the portable electronic device was assembled instead of broadcasted to the portable electronic device.
- Inventions Group IV and Group V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the capsule can be originally recorded or placed when the portable electronic device was assembled instead of broadcasted to the portable electronic device.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Eric Chen on June 4, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12. Applicant in replying to this Office action must make affirmation of this election. Claims 13-70 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### *Drawings*

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:
  - Elements 110,112,114,120 and 130 are nor described in the specification.  
A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
  - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
6. **Claim 7 is rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 contains the trademark/trade name Bluetooth. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a Bluetooth wireless networking protocol, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-6 and 9-12 are rejected** under 35 U.S.C. 102(b) as being anticipated by Amazon.com (Amazon).

Regarding claim 1, Amazon discloses a self-contained business transaction capsule (a software or account “1-Click”, Page 1). The capsule comprises data regarding the wireless transaction and transaction logic to complete the transaction (Page 1).

The capsule is adapted to be broadcasted to and stored on a portable electronic device (cellular phone or palm).

As to claim 2, Amazon discloses that the data regarding the wireless transaction includes at least one of a price, a transaction description and an image (Page1).

As to claims 3,4 and 12, Amazon discloses that the transaction logic includes at least one of billing and shipping information, order routing information, order status information, shipping status information and transaction rules and the transaction logic is adapted to transmit data from the portable electronic device to a transaction system (Pages 1 and 3).

As to claim 5, Amazon discloses that the completed transaction data is transmitted to the transaction system via at least one of direct dialing with a wireless telephone protocol, utilizing Short Messaging System (SMS) and via Transmission Control Protocol/Internet Protocol (using a cellular or a palm device, Page 1).

As to claim 6, Amazon discloses that the portable electronic device is a mobile wireless-enabled device (cellular or palm).

As to claim 9, Amazon discloses that the capsule is broadcasted to the portable electronic device by at least one of a radio wave, a TV signal, a cellular telephony signal, a satellite signal and an infrared signal.

As to claim 10, Amazon discloses that the portable electronic device includes a container for storing the capsule (memory of the device).

As to claim 11, Amazon discloses that the capsule communicates to a plurality of systems (to corroborate the credit card, etc) to complete the wireless transaction.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**10. Claims 1-6 and 9-12 are rejected** under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,512,919 to Ogasawara.

Regarding claim 1, Ogasawara discloses a self-contained business transaction capsule (Col. 3 Lines 4-13). The capsule comprises data regarding the wireless transaction and transaction logic to complete the transaction.

The capsule is adapted to be broadcasted to and stored on a portable electronic device (when the person dials the store number).

As to claim 2, Ogasawara discloses that the data regarding the wireless transaction includes at least one of a price, a transaction description and an image (Col. 14 Lines 23-28).

As to claims 3,4 and 12, Ogasawara discloses that the transaction logic includes at least one of billing and shipping information, order routing information, order status information, shipping status information and transaction rules and the transaction logic is adapted to transmit data from the portable electronic device to a transaction system (Col. 14 Lines 23-49).

As to claim 5, Ogasawara discloses that the completed transaction data is transmitted to the transaction system via at least one of direct dialing with a wireless telephone protocol, utilizing Short Messaging System (SMS) and via Transmission Control Protocol/Internet Protocol (using a cellular 18).

As to claim 6, Ogasawara discloses that the portable electronic device is a mobile wireless-enabled device (cellular).

As to claim 9, Ogasawara discloses that the capsule is broadcasted to the portable electronic device by at least one of a radio wave, a TV signal, a cellular telephony signal, a satellite signal and an infrared signal (Col. 5 Lines 1-9).

As to claim 10, Ogasawara discloses that the portable electronic device includes a container for storing the capsule (memory of the device).

As to claim 11, Ogasawara discloses that the capsule communicates to a plurality of systems (to corroborate the credit card, etc) to complete the wireless transaction.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**12. Claim 7 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Amazon.com (Amazon) in view of Bluetooth.

Amazon fails to disclose that the portable electronic device utilizes a Bluetooth wireless networking protocol. Amazon discloses that any wireless portable electronic device can be used (cellular, palm, etc).

Bluetooth teaches that is known in the art to have a portable electronic device that use a Bluetooth wireless networking protocol (Pages 2 and 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a Bluetooth wireless networking protocol, as taught by Bluetooth, into a portable electronic device as described by Amazon, in order to have a better communication.

**13. Claim 7 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,512,919 to Ogasawara in view of Bluetooth.

Ogasawara fails to disclose that the portable electronic device utilizes a Bluetooth wireless networking protocol. Ogasawara discloses that any wireless portable electronic device can be used (cellular, palm, etc).

Bluetooth teaches that is known in the art to have a portable electronic device that use a Bluetooth wireless networking protocol (Pages 2 and 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a Bluetooth wireless networking protocol, as taught by

Bluetooth, into a portable electronic device as described by Ogasawara, in order to have a better communication.

**14. Claim 8 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Amazon.com (Amazon) in view of E-Commerce Times, "Amazon and Sprint debut wireless Net Shopping (E-Commerce).

Amazon fails to disclose that the capsule is adapted to readily transmit from the portable electronic device to another portable electronic device.

E-Commerce teaches that Amazon is able to send gifts to other people using the wireless net shopping. Also, E-Commerce teaches that Sprint launches a PCS wireless web that offer many Internet tools (inside the wireless web) that includes sending or receiving emails (See Page 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to send a capsule (via email or other internet tool), as taught by E-Commerce, into the devices used by the people using Amazon, in order to permit other people to use the system.

**15. Claim 8 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,512,919 to Ogasawara in view of E-Commerce Times, "Amazon and Sprint debut wireless Net Shopping (E-Commerce).

Ogasawara fails to disclose that the capsule is adapted to readily transmit from the portable electronic device to another portable electronic device.

E-Commerce teaches that Sprint launches a PCS wireless web that offer many Internet tools (inside the wireless web) that includes sending or receiving emails (See Page 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to send a capsule (via email or other internet tool), as taught by E-Commerce, into the devices used by the people using the system described by Ogasawara, in order to permit other people to use the system.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents cited further show the state of the art with respect to self-contained business transaction capsules.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo. The examiner phone number is (703)-305-9747. The fax number for correspondence before a final action is (703)-872-9326 and the fax number for correspondence after final action is (703)-872-9327. The email direction of the examiner is carlos.lugo@uspto.gov. The examiner can normally be reached on Monday to Friday from 9:30am to 6:30pm (EST). If the examiner is not available, please leave a message, including the application number and the examiner will answer the message as soon as possible.

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June 5, 2003

  
J. J. SWANN  
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